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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,555	06/05/2002	Daniel Nestenborg	0104-0385P	6599

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

TRUONG, LINH T

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,555

Applicant(s)

NESTENBORG, DANIEL

Examiner

Linh Truong

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-7,9,12-16,20-23,26 and 27 is/are rejected.
- 7) ☒ Claim(s) 8,10,11,17,19,24 and 25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/19/02;12/10/02</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, 12-16, 18, and 26 rejected under 35 U.S.C. 102(b) as being anticipated by Hegarty AU-A-18442/83 (IDS).

For claims 1-4, Hegarty teaches a vaginal insertion device comprising a forward section 2 with a first forward opening into a first passageway and a rearward section 6 with a second forward opening 9 connecting a second passageway (figs. 1 and 2). Although Hegarty does not specifically teach a rectal insertion device, Hegarty's device is structurally similar to Applicant's claimed device and is therefore fully capable of being inserted into the rectum. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For claims 5 and 7, the first and second passageways and forward and rearward sections, respectively, are co-axially arranged (fig.2).

For claim 6, the forward end 6 of the rearward section is wider than the forward section 2.

For claim 9, the second forward opening is in the form of an annular opening formed around the forward section.

For claims 12-13, the forward portion 2 is a shaft that extends into the rearward section, which is a tubular element.

For claims 14-16, the first passageway extends throughout the shaft 1 and that extends rearwardly into tubular element 6, and shaft 1 is spaced from the inner wall of the tubular element 6.

For claim 18, the rearward portion is also a gripping portion for maneuvering the insertion device.

And for claim 26, the first passageway 2 is tapering towards the forward end, making it the most narrow part of the first passageway.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hegarty AU-A-18442/83 (IDS).

Hegarty does not disclose the range in length of the protruding forward section of the rearward section for safe insertion. As seen in fig. 1, the rearward section is

projecting for the user. It would have been obvious to one with ordinary skill in the art at the time the invention was made to have Applicant's claimed ranges, since it has been held in the art that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 22-23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hegarty AU-A-18442/83 (IDS) in view of Dvarsater WO 99/30652 (IDS).

For claims 22-23, Hegarty does not teach a collection bag for collecting feces. When a rectal insertion device is inserted into the anal canal of a human or animal, waste can be produced, and, thus, a collection receptacle is needed for collecting the waste. Dvarsater teaches a rectal insertion device with a collection bag 12 for collecting feces. Therefore, it is obvious to one with ordinary skill in the art at the time the invention was made to provide the insertion device with a collection bag.

For method claim 27, Hegarty teaches the claimed device but does not teach inserting the device into the anal canal. Dvarsater teaches inserting a device into the anal canal for the treatment of disorders of the digestive tract. Since, as noted in the 102 rejection, Hegarty's device is fully capable of being used as a rectal insertion device, it is obvious to one with ordinary skill in the art to use the method of Dvarsater to insert Hegarty's device into the anal canal of a user.

Allowable Subject Matter

Claims 8, 10-11, 17, 19, and 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh Truong whose telephone number is 703-605-4974. The examiner can normally be reached on Mondays to Fridays from 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh Truong

L.T.


Larry I. Schwartz
Supervisory Patent Examiner
Group 3700